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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,875	01/12/2001	Jerome L. Krupa	P1329USA	2537

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EXAMINER

LEE, DIANE I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/759,875

Applicant(s)

KRUPA, JEROME L.

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 91-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 96-104 is/are allowed.
- 6) ☒ Claim(s) 91-95 and 105-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 23 March 2004. Claims 15-90 have been canceled and claims 91-109 have been newly added. Currently, claims 91-109 are pending in the application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/23/04 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 91-95 and 105-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Re claim 91: In lines 9-10 read, "a scanner capable of reading and comparing both the first and the second bar code simultaneously to determine if the second bar code corresponds to the first bar code." How can a reading and a comparing operation be carried out simultaneously? The bar code would have to be captured and converted to an electrical signal prior to processing, such as decoding, comparing, and etc., which all typically takes place in sequential order. It is unclear how can a scanner

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simultaneously process the sequential operations. In light of the specification (i.e., the applicant's disclosure stated that the bar code reader 76 to scan the bar codes 38 and 64 and the reader 76 is programmed to read both bar codes 38 and 64 simultaneously, see page 17, lines 6+). The above limitation has been translated as

-- a scanner capable of reading both the first and the second bar code simultaneously and subsequently comparing to determined if the second bar code corresponds to the first bar code --.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 91 -95 and 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blanford et al. [US 6,561,426-referred as Blanford].**

Re claims 91 and 94-95: Blanford discloses a system having a first label (a primary label 102) having a single layer and a first machine-readable bar code and a second label (a supplemental label 104) attached the product or container. The second label having a second machine readable bar code with a specific alignment with respect to the first bar code (i.e., the first bar code and the second bar code are substantially aligned side-by-side, such that the second bar code is posited as to partially obscure the first bar code (see col. 3, lines 3+ and figure 1). Wherein the first bar code label provides information about a particular product (i.e., product identity) and the second bar code label identifies the particular product information desired to be distributed to a consumer, e.g., an indication that the identified product has been marked down (see col. 2, lines 13+). The system includes a scanner 202 capable of reading both the first

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and the second bar code and subsequently comparing to determine if the second bar code corresponds to the first bar code (see col. 5, lines 26+).

With respect to the container suitable for a pharmaceutical and the second bar code identifying the particular pharmaceutical desired to be distributed to a patient, a recitation of the intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Blanford fails to teach the scanner capable of reading both the first and the second bar code simultaneously.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the old and well-known imaging system, such as CCD that capable of simultaneously capturing the image of the bar codes in the system of Blanford in order to reduce the scanning time by simultaneously capturing the first and the second bar code by imaging.

Re claim 92: the fact that applicant has not explicitly described the first portion and the second portion of the second label, the second label of Blanford (i.e., the supplemental label) having many portion, i.e., an upper portion having an upper left portion and an upper right portion, a lower portion having a lower left portion and a lower right portion, a left portion, a right portion, and a center portion, and etc.). Thus, one of the above portion is aligned with the first bar code (see figure 1).

Re claim 93: Blanford does not teach the first portion includes at least one of typewritten and a handwritten prescription information.

However, it would have been an obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the label, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the

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invention from the prior art in terms of patentability, *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information for the container does not alter the functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

7. Claim 106 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al. [US 6,599,481 B2].

Steven discloses a container suitable for pharmaceutical and affixing a label 40 having a symbol to the container (see 1). The symbol having indicia that identify the pharmaceutical to be packaged in the container (see col. 2, lines 14+). The bar code on the label is used to create direct link between the container, the patient, and the test request form, which serves as the information identifying a particular pharmaceutical desired to be distributed to a patient.

Steven does not disclose the specific use of the label and symbol.

Moed teaches a system 10 for reading and decoding a container (package 20) information, and the container having a destination address data 38 with a symbol 42 and an identification data label 36 printed and affixed to the container (see col. 5, lines 25+ and figure 2). The system reads the destination address data 38 with a symbol 42 and the identification data label 36 simultaneously by an imaging system 12 and a label decoding system 14 determine if the information on the identification data label 36 corresponds to the indicia on the destination address data 38 with a symbol 42 (see 9, lines 27+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the label and the symbol in the teaching of Steven in order to provide a system that capable of automatically reading, identifying and tracking the container.

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8. **Claims 107 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens as modified by Moed, as applied to claim 106 above, and further in view of Kabata [JP 01-94492].** The teachings of Stevens as modified by Moed have been discussed above.

Stevens as modified by Moed does not teach both symbol indicia and the label information are bar codes and the reading is accomplished through the use of a hand-held bar code scanner.

Kabata teaches the use of two bar codes and a hand-held bar code scanner for identification.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teaching of Kabata in the identification system of Stevens as modified by Moed in order to simplify the structure of the system.

9. **Claims 108 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens as modified by Moed and Kabata, as applied to claim 106 above, and further in view of Bandford.** The teachings of Stevens, Moed, Kabata, and Bandford have been discussed above.

Stevens as modified by Moed and Kabata does not disclose a portion of the label covering a portion of the indicia on the symbol.

Bandford shows a portion of the second bar code label covering a portion of the first bar code label.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the placement of the two bar code symbols in the teaching of Stevens as modified by Moed and Kabata in order to reduce the imaging area which reduces the less processing decoding time.

Allowable Subject Matter

10. **Claims 96-104 are allowed.**

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11. The following is an examiner's statement of reasons for allowance: the best prior art of the records fails to teach or fairly suggest the a pharmaceutical container having a symbol with specifics claimed single-layered label having first outer boundary portion and second outer boundary portion extending out and away from the outer boundary of the first portion and wherein the second portion having a patient identifying indicium aligned with the symbol of the container so as to allow both the symbol and the indicium to be scanned together by a detector in order to confirm the contents of the pharmaceutical container, as set forth in the claim.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

12. Applicant's arguments with respect to claims 91-109 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.